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EXAMINER
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ART UNIT	PAPER NUMBER
1751	18

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/319,204	Applicant(s) DE LA METTRIE ET AL.	
	Examiner Margaret Einsmann	Art Unit 1751	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on 1-9-02

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) 32-64, 67, 69-76 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) 32-64, 67, 69-76 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

The request for reconsideration filed 1/09/02 has been entered into the file and applicant's remarks carefully considered.

Applicant's remarks regarding the provisional obviousness double patenting rejection over application serial number 09/319,165 have been noted. The rejection remains of record since no terminal disclaimer has been presented.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are rejected as redundant as claiming the same composition as claim 32. This rejection is maintained for the following reasons. Applicant does not argue that the composition in the three claims is exactly the same, as the rejection states. He argues that the substrate on which the composition is used is different. This argument may be persuasive in a method claim. However, the intended use bears no weight in a composition claim. The claimed composition in the three claims is exactly the same. If applicant intends to claim a composition of different scope in claims 33 and 34, they must be amended to reflect a scope different from the scope of claim 32.

Claim Rejections - 35 USC § 103

Claims 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamahatsu, EP 716,846. This rejection is maintained primarily for the reasons of record as set

forth in paper #16 mailed 10/10/2001. Applicants arguments rely heavily on the court's decision in In re Baird. This office views the issues in this application as non-analogous to the issues in the In re Baird case. Applicant argues by using a statistical analysis. In the first part of the analysis, applicant states that there are 8436 different combinations of said three dyes claimed as equivalent in Yamahatsu. That, of course, is if the list of 38 dyes existed in a vacuum. In reality, they do not exist in a vacuum. By reference to Yamahatsu's examples, one sees that nearly all of the examples use mixtures of at least three dye intermediates, and two of those three are p-phenylenediamine and p-aminophenol, which are two of applicant's claimed dye intermediates. In fact, applicant does not claim a mixture of three specific dye intermediates. Applicant's claims comprise many more than 8436 different combinations.

Applicant claims a mixture of:

1. at least one first oxidation base from the class of most of the well known oxidation bases except for unsubstituted para-phenylenediamine (which is unarguably the best known and most widely used oxidation base) and p-aminophenols

2.at least one oxidation base from the class of paraminophenols ; and

3 at least one meta-amino phenol coupler. Referring to patentee's examples, one sees that Yamahatsu frequently uses a mixture of p-phenylenediamine. p-aminophenol and meta-aminophenol in Tables 1,5,6 of the experiments and examples 1,5, 7,9 and experiment 6. Therefore in most of the examples, applicant's 2 and 3 components are used, and unsubstituted para-phenylenediamine is used. Referring to applicant's Table 1 invluded with this response, one sees that Yamahatsu nearly always uses one dye from each of columns 2 (p-aminophenol dyes) and 3 (m-aminophenol dyes). According to applicant's analysis 28 dyes are neither p-

aminophenols or m-aminophenols. Accordingly, in order to arrive at applicant's claimed composition, one is picking or choosing only one dye from the 28 dyes in the first column of "other dyes" in order to arrive at the third claimed dye component. The odds of choosing a dye from column 1 is further reduced because several of the dyes used are in actuality the same dye in two or three forms; dyes 3 and 14 are the same dye; dyes 21 , 22 and 25 are a dye and salts of the same dye; dyes 24 and 28 are the same dye in two different forms as are dyes 2 and 17. Considering the salts as the same as the dye itself, the dyes in column 1 are thus reduced to 23 dyes. In order to arrive at the composition claimed from a true reading of Yamahatsu, applicant must note that Yamahatsu most frerquently uses a combination of p-phenylenediamine and a p-aminophenol and a p-aminophenol. Thus, in order to arrive at applicant's composition, one only needs to substitute an equivalent dye for the primary oxidation dye p-phenylenediamine in patentee's preferred compositions as noted above. Applicant has appended a copy of chapters from Zviak, which contains a basic teaching on oxidation dyeing. On page 265 is the teaching that in order to form deep shades, aromatic amines or aminnophenols with amino and hydroxyl groups in ortho or para position to each other must be used. "One of the intermediates in the copolymerization must always be an ortho- or para-diamine or aminophenol" Applying this teaching to Table 1, one dye from either or column 1 or column 2 must always be used. These are sometimes called primary intermediates. But as discussed above, Yamahatsu exemplifies using two of the above listed intermediates nearly all of the time. Turning to page 266 of Zviak, he lists the couplers (modifiers which must be used in combination with one or more of the above listed ortho or para substituted aromatic amines or aminophenols). Zviak teaches that the dye intermediates on that list are equivalent in that they (1) may be included in oxidation dyeing

compositions (2) form feebly colored dyes when used alone and (3) must be used in combination with **at least one or more** or the ortho or para substituted diamines or aminophenols . Accordingly, it is well known to use more than one primary intermediate in oxidation dyeing compositions. With that in mind, one sees the flaws in applicant's original statement that one may pick and choose any combination of the 38 dyes for use in any oxidation dyeing composition. The equivalence of the 38 dyes only exists in so far as they are all suitable for use in Yamahatsu's oxidation dyeing compositions. Applicant's claims amount to claiming a composition containing two primary intermediates chosen from two classes of notoriously well known primary intermediates combined with chosen from well known couplers.. Yamahatsu teaches that two primary intermediates are usually used, and then a coupler is nearly always used. The dyes in column 3 of applicant's Table 1 are equivalent couplers. When one makes an analysis of the teaching of a reference, one must always combine what is known to one skilled in the art with the teaching of equivalence in that reference. While Yamahatsu clearly perfers the use of p-phenylenediamine in the compositions of the working examples, he also teaches that other primary oxidation bases may be substituted for p-phenylenediamine. He does not teach that all of the 38 dyes are equivalent. He realizes that one skilled in the hair dyeing art will not substitute a coupler for a primary intermediate. Applicant further argues that Yahamatsu teaches away from applicant's composition because applicant's third dye is not listed as particularly preferred. All disclosures of the prior art, including non-preferred embodiment, must be considered. See In re Lamberti and Konort, 192 USPQ 278 (CCPA 1967); In re Snow 176 USPQ 328(CCPA 9173) All of the disclosures in a reference must be evaluated for what they fairly teach to one or ordinary skill in the art. In re Smith, 32 CCPA 959, 148 F.2d 351, 65

USPQ 167; In re Nehrenberg, CCPA 1159, 280 F. 2d 161, 126 USPQ 383. Note M.P.E P. 2123,"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. In re Heck, 699 E.2d 1331, 1332-1333, 216 USPQ 1038, 1039 (Fed Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843(Fed. Cir.) cert. denied, 493 U. S. 975 (1989). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). The list of 38 dyes thus must be analyzed together with the knowledge of a hair color chemist in order to arrive at the appropriate dyeing mixtures, realizing that not all combinations of the dyes listed are appropriate. A hair color chemist would know that Yamahatsu would substitute a primary intermediate for p-phenylenediamine, several of which are listed in column 1 of applicant's Table 1, six of which are within the scope of applicant's claims.

Claims 32-64, 67, 69-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotteret, U.S. 5514188 in view of Tsujino, U. S. 4,961,925. This rejection is maintained primarily for the reasons of record as set forth in paper #6 mailed May 9, 2000 and in paper # 16 mailed 10/10/01. The arguments of this office presented in the final rejection mailed on 10/25/2000 are also maintained.

Applicant argued in a previous response that the skilled artisan would not expect equal dyeing capacity between conventional oxidants and those of Tsujino. Applicant stated that Tsujino's compositions provide inferior dyeing and thus there is a tradeoff, even if decreased irritation and damage to the hair and skin results from the substitution. This office respectfully disagrees. Table 1 discloses that examples 1-3 and 1-5 containing the glucose/glucose oxidase system and additionally peroxidase; and 1-7 to 1-10 comprising the uric acid/ uricase system all provide hair dyed a thick dark brown color which is equivalent to examples 1-12 and 1-13 which provide the same level of hair coloration but additionally leave the hair with inferior properties regarding softness and inferior combing. Applicant refered to examples 1-1, 1-2 and 1-4 where the hair coloration is inferior. In the opinion of this office, by providing compositions which provide equal dyeing properties patentee is teaching how to use his invention to both decrease the inferior hair properties and obtain the same dyeing results. Note the statement in col 5 lines, 48-50 wherein applicant teaches how to improve the dyeing properties by incorporating mutarotase and/or peroxidase into the compositions using the glucose oxidase system. Additionally, it is noted that the uric acid/uricase system does not depend on the addition of mutarotase or peroxide to provide excellent dyeing properties as well as superior softness and combing properties.

Applicant further argued that this office is over generalizing the teachings of Tsujino since all of the examples of Tsujino use only one dye. Table I is the results of the experimental findings of Tsujino, not working examples of hair compositions. In order to compare results in an experiment, a scientist uses equivalent compositions, varying only the component that is being tested. Patentee's experimental results would have been invalid if he had used different

dyes in each experiment. Applicant should note patentee's working examples, all of which use combinations of primary oxidation bases and couplers; many using applicant's paraaminophenol, paraphenylenediamine and at least one coupler. (Noting applicant's Table 1. This is one from column 2, one from column 3 and at least one coupler from column 1.)

In the response filed 1/09/01, applicant further argues that the instant case is analogous to the case decided in *In re Dien*. In *Dien* the primary reference taught that the basic reaction was less than satisfactory. Where in Cotteret there is there an analogous statement? The board stated that prima facie obviousness cannot be inferred from the alleged inadequacies of the prior art. The examiner cannot find a statement in Cotteret et al. that their process is less than adequate. Patentee then goes on to challenge the results of Tsujino. Applicant states four reasons to suspect the findings of Tsujino.

1. Tsujino uses 5.1% hydrogen peroxide in his comparative examples 1-12 and 1-13 while he states the appropriate range in col 3 lines 15-17 to be 1.5% to 4.0% by weight. Note that this is 5.1% of the oxidizing solution, not of the solution applied to the hair. There are two compositions in each example: the dye solution and the oxidizing solution. In order to dye the hair the two solutions are mixed w/w and applied to the hair. Thus the percentage of hydrogen peroxide applied to the hair is 2.5%, which is clearly within Tsujino's range. Note Cotteret, '188 col 7 lines 19-20, "at the time of use, this composition is mixed, weight for weight, with hydrogen peroxide..." This is the conventional method of application.

2. There is no expectation of success in using more than one oxidation base when the table of experimental results uses only one dye. Refer to the discussion of Table 1 (experimental data) and Tsujino's application examples in the paragraph supra for the response to this argument.

3. Applicant states that Tsujino teaches "almost equivalent results. " In the opinion of this office, by providing compositions which provide equal dyeing properties patentee is teaching how to use his invention to both decrease the inferior hair properties and obtain the same dyeing results. Note the statement in col 5 lines, 48-50 wherein applicant teaches how to improve the dyeing properties by incorporating mutarotase and/or peroxidase into the compositions using the glucose oxidase system. Additionally, it is noted that the uric acid/uricase system does not depend on the addition of mutarotase or peroxide to provide excellent dyeing properties as well as superior softness and combing properties. Note also the statement in col 3 lines 22-25, "In the present invention, since oxygen in air is activated and utilized, hair damage and skin trouble are less occurred and also ***the same dyeing and bleaching effects as that by the conventional method may be imparted***." Applicant further doubts that the compositions having the same symbol are equal. This of course is a statement without any evidence and thus has the status of a mere opinion.

4. Applicant again refers to the statement in Tsujino that the dyeing effect will be almost the same. Note col 5 lines 48-50 combined with the evidence in the table showing improvement over the conventional hydrogen peroxide dyeing in examples 1-12 and 1-13 and the statement quoted above from column 3 lines 22-25.

Since all arguments presented in the most recent response are not persuasive for the reasons given above, the rejection must be maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M. The fax phone number for this Technology Center is (703) 305-3599

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Margaret Einsmann

MARGARET EINSMANN

PRIMARY EXAMINER 1751

March 6, 2002